IN THE

Supreme Court of the United States

OCTOBER TERM, A. D., 1948.

No. 305.

THE GALION METALLIC VAULT COMPANY, *Petitioner,*

v.

EDWARD G. BUDD MANUFACTURING COMPANY, *Respondent.*

SUPPLEMENTAL BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, the Galion Metallic Vault Company respectfully calls the attention of the Court to a decision by the Ninth Circuit Court of Appeals which supports our position in our Petition for Certiorari and Brief in Support Thereof and which is in conflict with the decision of the Third Circuit.

Refrigeration Engineering, Inc. v. *York Corporation,* 168 F. (2d) 896 (CCA 9), decided June 29, 1948, Petition for Certiorari to the Ninth Circuit Court of Appeals filed September 25, 1948, Docket No. 309.

The Ninth Circuit Court of Appeals said:

"Plaintiff contends that defendant's device . . . is incomplete without the element of 'a refrigerated space,' as a part thereof, and that, since plaintiff does not manufacture or sell a refrigerated space, there is no infringement 'unless an equivalent element is supplied.' While this argument is interesting, it is not persuasive. The stipulation . . . and the evidence clearly reveal that the accused device of plaintiff was designed, built and advertised *to operate within*, and in conjunction with, a refrigerated space in the same manner as the device of the defendant.

"Claim 13 contains the phrase, 'In combination with a refrigerated space,' but this does not mean that a refrigerated space is an element of the invention. Instead, it merely indicates where the invention is intended to be used. We take it that the claim might with equal propriety have read 'to operate in conjunction with' or 'in association with' a refrigerated space, or perhaps with more accuracy, 'within' a refrigerated space. That the described combination of elements performs its coil-defrosting function only when operating 'in combination with a refrigerated space' does not militate against the patentability of defendant's claim or absolve plaintiff's device of its infringing character.

"A patent claim for an oxygen-supplying combination device designed to be automatically operative only 'in, or within the stratosphere' most certainly would not entail the necessity of claiming the stratosphere itself as one of the necessary physical elements of such a device. 'Interstellar space' is not a saleable commodity, yet a device designed for the sole purpose of performing its claimed functions 'within' and only within a certain specified area of such a space would certainly possess elements of novelty and utility. To use a more mundane analogy, one whose patent claim or claims cover some new mechanical device for use *only* 'in combination with' the previously known internal combustion engine, could not claim, as such, the antecedent engine to which it necessarily must be affixed in order to function. To say that plaintiff produces a defrosting unit but does not 'sell' along with it the 'refrigerated space' within which alone it must

operate, is to announce the obvious, but this proposition has no such significance as plaintiff attaches to it.

"Neither plaintiff nor defendant makes or sells a refrigerated space in conjunction with its product. The evidence abundantly supports the conclusion that what both parties *do* manufacture and sell is a device comprised of the elements set forth in claim 13 of defendant's patent and faithfully reproduced by plaintiff. Plaintiff's argument based upon the fact that it purveys no 'refrigerated space' is ingenious but fruitless.

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"At the close of all of the evidence, plaintiff moved to amend its complaint to add the following charge: 'Defendant is barred from the relief sought in the McAdam patent because it has misused the patent in an effort to control competition on unpatented devices.'

"Plaintiff offered this motion to make the pleadings conform with what it asserted to be the proof. Actually, there was no proof that defendant had misused the patent. The motion was properly denied."

168 F. (2d) 896, 900, 901.

Thus, it will be seen that the decisions of the Courts of Appeals for the Third Circuit and the Ninth Circuit are irreconcilable and in complete conflict with one another not only from the standpoint of the conclusions reached, but also from the standpoint of the premises and reasoning advanced in support of such conclusions. This Court should review the situation in order that there may be a determinative evaluation of this important phase of patent law in the interest of uniformity of decision.

We earnestly submit that this Court should order up this case.

Respectfully submitted,

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